

REMARKS/ARGUMENTS

The Applicant has carefully reviewed the application in light of the January 20, 2004 Office Action. In Response, Applicant has cancelled claims 1-5 and 12; amended claims 6-11 and 13-20 and added new claim 21. Reconsideration and reexamination of the application, as amended is respectfully requested.

CLAIM REJECTIONS

Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Okisawa, Japanese Patent JP411092722A in view of Williams (U.S. Patent No. 4,557,971). Applicant has obtained a translation of the Okisawa reference, enclosed herewith.

As shown in the translated Japanese patent, it is concerned with adhesive tape having a list of names printed thereon for sealing packaging boxes. As shown in drawings 1-4, each roll of tape is printed with a listing of the rooms in side-by-side arrangement. For example, with respect to drawing 1, the following is printed on the tape:

Living Rm.	Kitchen	Entrance	Bathroom	Illegible	Storage
Illegible		Living Rm	Kitchen		
Japanese 1	Japanese 2	Japanese 3	Western 1	Western 2	Western 3
Upstairs	Japanese 1	Japanese 2			

In drawing 3 the following is listed:

Locker 1	Locker 2	Locker 3
Desk 1	Desk 2	Desk 3

Once the box is sealed with the tape, the pertinent pre-printed name of the room or other reference character is circled using a writing instrument.

Williams teaches a multiple layered laminated tape having a strength layer and a permeable layer which is suitable for printing or marking. William discloses in column 2, lines 23-28 that the permeable layer may be written on by pen, marker or the like for addresses or for stamping of messages. Williams also teaches self-adherable tape having "handle with care" or "fragile" pre-printed thereon.

To establish *prima facie* obviousness of a claimed invention three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed. Cir. 1991)).

The present invention resides in a packaging tape system and process for packaging articles to be moved. Claims 17 and 19 have been amended to recite that the adhesive tape has indicia repeatedly pre-printed thereon indicating a single room or location in a house from which the contents of the box originated or are destined. Moreover, independent claims 17 and 19 have been amended to recite the box can be sealed and labeled simultaneously without marking the box or tape with a writing instrument.

Okisawa, in contrast, pre-prints all of the intended rooms of the house, office, etc. In drawing 1, eighteen different designations or rooms are listed. In drawing 3, six different locations or destinations are listed. Drawings 2 and 4 illustrate abbreviations or symbols which can represent multiple different rooms or locations. Moreover, Okisawa specifically and particularly teaches that a selected room or location is circled with a writing

instrument so as to identify the destination of the box. Whereas the present invention utilizes color to distinguish multiple rooms, there is no teaching in Okisawa of distinguishing rooms, for example multiple bedrooms or bathrooms. A mover using the Okisawa tape circled "bedroom" would not know which bedroom the box belonged in the new house.

Williams also teaches of utilizing a writing instrument to mark or write upon the permeable tape Williams discloses. The only pre-printed messages are "handle with care" and "fragile", neither of which indicate a single room or location in an office or house from which the contents of the box originated or are destined.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

All the claim limitations of claims 17 and 19 have not been taught or suggested by Okisawa or Williams or the combination thereof. In fact, these references actually teach away from the claimed invention as the claimed invention is intended to simultaneously label and mark a box without the need for manually marking the tape or box with a writing instrument. The background section of the present patent application discusses the disadvantages of having to manually mark boxes and tape. Instead, claims 17-20 discloses a packaging tape system wherein a single room or location is repeatedly printed on the tape so as to be easily seen and not require a writing instrument, which presents legibility concerns and can smudge or accidentally be rubbed off of the tape. Moreover, the claimed invention preferably utilizes multiple rolls of tape of different color to further enhance and facilitate the distinguishing between boxes quickly and at a distance when moving.

Given the large number of different rooms and locations printed on the Okisawa tape, one would have to be very close and stop to examine the tape and box to determine where the contents originated or where they were destined. Moreover, smudging of the ink of the writing instrument is a

well-known problem, further exacerbating the “determination of the destination or origination of the contents of the box when moving.” The hand-written markings disclosed by Williams requires the deciphering of one’s handwriting, the possibility of smudging the ink, and there is no discussion whatsoever of the rooms or locations within a house or office, as recited in independent claims 17 and 19. Thus, as these references fail to establish all of the claim limitations of these amended claims, *prima facie* obviousness cannot be established and the claim rejections should be withdrawn in light of the amendments.

As stated by M.P.E.P. §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Citing, Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 218 USPQ 698 (Fed. Cir. 1983). Further, a prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention. M.P.E.P. §2141.02, citing, W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. Denied, 469 US 851 (1984). When considering both the Williams and Okisawa references in their entirety, that is as a whole including portions that would lead away from the claimed invention, Applicant respectfully asserts that the claimed invention as a whole is not obvious.

Claims 9-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitagawa et al. (U.S. Patent No. 5,099,991) in view of Okisawa. Kitagawa teaches a method of packing electrolytic capacitors within a box. Applicant fails to see the critical elements of the claimed invention which Kitagawa discloses. Applicant respectfully asserts that Kitagawa does not overcome the shortcomings of Okisawa, as discussed above.

Claims 6-8 and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Plummer (U.S. Patent No. 4,252,258) in view of Williams. Plummer teaches a gang tape dispenser for multiplicity of

dissimilar rolls of pressure sensitive tape selectively usable at the user option. Plummer discloses that each roll may bear a distinctive symbol and/or color dissimilar from those on the other rolls enabling the user to employ the strip alone or in combination for coding and/or identifying articles.

However, neither Plummer nor Williams discloses pre-printing indicia repeatedly on each roll of the adhesive tape along the length thereof indicating a single room or location within a house or office. Neither Williams nor Plummer mentions "bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room, break room, conference room, file room, reception area, etc.). In fact, neither Williams or Plummer are at all analogous or related to packaging articles to be moved using adhesive tape having pre-printed indicia representing the single room or location within the house or office from which the contents of the box originated or are destined and which simultaneously seals and labels the box without marking the box or tape with a writing instrument.

Although one could mark or write on the tape of Williams, Williams does not disclose the moving and packaging tape system or process of the present invention with any degree of particularity. Moreover, such hand writing and marking is contrary to the claimed invention and presents problems and disadvantages as discussed in the application. Labeling boxes having numeric indicia or other symbols, even if color coded, does not arise to the present claimed invention.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. Inc. V. Montefiore Hosp., 732 F.2d 1562, 1577, 221 USPQ 929,933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Applicant respectfully asserts that the teachings of these

references cannot be properly combined as there is no suggestion or incentive to do so within the references that is "clear and particular". Moreover, Plummer and Williams fail to teach all of the limitations of these amended claims. The assertion in the Office Action that "it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct a tape dispenser by Plummer with a pre-printed indicia as taught by Williams is to provide a means to convey the destination or room contents of the box in which the tape is applied" is completely unsupported and baseless. Once again, neither Plummer nor Williams disclose, teach or even infer means to convey the destination or room contents of the box using pre-printed indicia as recited in the claims of the present invention.

Although Williams discusses printing a destination address on the tape, this does not arise to providing repeatedly pre-printed indicia on a roll of adhesive tape indicating a single room or location within a house or office from which contents of the box originated or destined. Rather, the destination address is merely a street address or an office address within a building. The specific legend "bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room, etc." do provide a non-obvious functional relationship with the tape as it not only illustrates that the contents of the box originated from the room or location pre-printed on the tape, but also instructs the mover to place this labeled box in such location in the new house or office. If this specific legend were merely a design consideration, stars, hearts, or non-sensical words could be utilized. However, these design selections would convey absolutely nothing as to the origination of the contents of the box and the destination of the box from one house or office to another. Thus, Applicant believes that it is very clear that the indicia, as claimed, has a functional relationship with the tape which must be taken into account and which arises to patentable distinction between the other tapes and systems referenced by the Examiner.

Claims 9 and 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitagawa, in view of Plummer and Williams. Once again,

Williams discloses a multiple layered laminated tape having a strength layer and a permeable layer which is suitable for printing and marking. Plummer discloses a multi-gang tape dispenser. Kitagawa discloses a process for packaging electrolytic capacitors within a box.

It is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clontech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000).

It appears as if the Examiner has inappropriately used Applicant's claims as a framework from which to pick and choose among individual references to recreate the claimed invention. Of course, it is well-known that such hindsight is impermissible and strictly forbidden. It is also well-known that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from a reference only so much of it that will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. Bausch & Lomb v. Barnes Hing/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Neither Kitagawa, Plummer or Williams (or the combination thereof), teach of utilizing adhesive tape having indicia repeatedly pre-printed thereon indicating a single room or location from which the articles were taken within a house or office or where the box or the articles is destined within the house or office, and which simultaneously seals and labels the boxes without the need to mark the tape or box with a writing instrument, as recited in the independent claims of the present invention.

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness as to the amended claims: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430

(Fed. Cir. 1990). Instead, it appears as if the Examiner is inappropriately using Applicant's claims as a framework from which to pick and choose among individual references, with complete disregard to the analogous nature of the references, to recreate the claimed invention. Of course, this is impermissible and strictly forbidden.

As discussed above, and on numerous occasions during the prosecution of this application, the present invention is directed to a packaging tape system and process for moving which assists the movers by simultaneously sealing and labeling a box with a single room or location within the house or office from which the contents of the box originated or destined within the house or office. Doing so without requiring the marking of the box or tape with a writing instrument, utilizing color coded tape, and printing indica representing a single room or location (which aids in viewing the information on the tape from a distance) is not taught whatsoever in the prior art cited up to this point by the Examiner. This arrangement overcomes many of the problems encountered in the prior art when packaging and moving boxes, as described in the application. In the rare case where the prior art does not appreciated the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

CONCLUSION

From the foregoing amendments and remarks, Applicant respectfully asserts that the currently pending claims, as amended, are patentably distinct from the cited references and in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

KELLY BAUERSFELD LOWRY & KELLEY, LLP

A handwritten signature in black ink, appearing to read "Aaron T. Borrowman", is written over the firm name and extends to the right.

Aaron T. Borrowman
Registration No. 42,348

ATB/kr
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900